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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,393

07/25/2003

Jarret L. Redd

SF005C

3935

7590

09/03/2004

Xin Wen
2800 Bridge Parkway
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EXAMINER

RUTLEDGE, DELLA J

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,393

Applicant(s)

REDD ET AL.

Examiner

D. Rutledge

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.
2. The declaration is defective because the applicant is seeking to claiming priority benefit under 35 USC § 120, but the applicant listed the current application number rather than the parent application, 09/450,899, as application from which the applicant is seeking priority. Correction is required.

Priority

3. The applicant has claimed benefit from provisional application 60/167,675. The number is not correct, the present inventors are not the inventors of the 60/167,675 provisional application. The correct provisional application number must be provided and the first line of the specification must be corrected.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4 – 8 and 11 -14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US 6,154,295).

Fredlund et al. have a printing system for producing an image print having a customized message from a user to a recipient on the back side of the image print. The basic system is shown in Fig. 1. Column 4, lines 3 – 9 and 29 – 36 disclose that the customer may provide a message to be recorded on the back side of a print. The images may be sent to the customer or to any one designated by the customer. The images may be in the form of a greeting card. The computer 26 has an algorithm and controls the sequence of steps of all the processes (developing, scanning, printing, etc.) such that a scheduler is inherently a part of the system.

7. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US 6,164,295).

Fredlund et al. do not specifically describe the type of written message. One would assume the message relates to the image or otherwise why send the image. The courts have held that where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, WL 1068957 (Fed. Cir. May 13, 2004). Since in this case the message or printed matter is not related functionally to the product, the image or print, whatever the

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content of the message of the customer of the Fredlund et al. system, the claim is met by the reference.

8. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US 6,154,295) as applied to claims 1, 4 – 8 and 11 - 14 above, and further in view of Garfinkle et al. (US 6,570,640), Williams et al. (US 6,388,732) or Nozaki et al. (US 6,349,194).

Fredlund et al. does not disclose using the photographic printing system with the Internet. The secondary references disclose using a photographic process or photofinishing process in connection with the Internet. One of ordinary skill in the art at the time the invention was made would be motivated to use the teachings of the secondary references to provide a photofinishing processing over the Internet because such a service would reach a new customer base to expand the current business and would take advantage of a widening technical source that is currently very popular.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clark (US 5,428,423) and Lee et al. (US 5,757,466) disclose backprinting a message on the rear of a photographic image.

Response Data

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Rutledge whose telephone number is (571) 272-2127. The examiner can normally be reached on Mon - Thurs, 6:00 AM - 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Rutledge
Primary Examiner
Art Unit 2851

dr
8/30/2004